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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,742	01/28/1999	ALAIN A. MEILLAND	006450-301	5955
21839	7590	11/14/2005	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			LOCKER, HOWARD J	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/238,742	MEILLAND, ALAIN A.	
	Examiner	Art Unit	
	Howard J. Locker	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 August 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 (the claim) remains rejected under 35 U.S.C. 102(b) as the instant plant was described in the following printed publication more than one year prior to the date of application for Plant Patent (January 28, 1999) in the United States:

QZ PBR 970101 (published on April 15, 1997); taken in view of the admission that "*Plants of the 'Meinusian' variety were made available to the public in France on May 20, 1996*" as stated at page 4 of applicant's April 7, 2004 and applicant's admission that "*Plants of the 'Meinusian' variety were first made available to such amateur growers in the country of France during September 1996*" as set forth in applicant's August 26, 2005 response.

(This rejection was previously set forth in paragraph 1 of the Office action mailed May 26, 2005) and remains applied as therein, with applicant's additional admission (referenced above) added. Applicant's request for reconsideration and accompanying arguments (filed August 26, 2005) have been considered but are not found persuasive to patentability.

The above referenced published application constitutes a "printed publication" under 35 U.S.C. 102 because it was accessible to persons concerned with the art to

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which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). See also MPEP Section 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the grant and application are obtainable through the Plant Variety Rights Journal. Plant varieties are also entered in the Register of Community Plant Variety Rights and Register of Applications for Community Plant Variety rights, both of which are open to the public. Thus, information regarding the claimed cultivar, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ 2d, 1618, 1620, (Bd. Pat. App.& Inter. 1992) (“The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications.”). See also MPEP 2121.03.

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It has been determined (and conceded by applicant) that the above publicly available publication discloses the claimed plant variety and it has been conceded by applicant that said claimed variety was made available to the public in France more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published application, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant.

By way of explanation, information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publication standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. The prior sale more than one year prior to the filing date of the instant application enables the referenced published document because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation, in the Genus Rosa, as shown for example in the Huxley et al. excerpt (newly cited). See, e.g., *Thomson*, supra. See also Cooper, "Biotechnology and the Law", Section 8.05, pages 8-15 to 8-16 (August 2000), Clark, Boardman, Callaghan ("In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public.").

The clear wording of 35 U.S.C. 102(b) is “A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...”. There is no geographic limitation of the bar under 35 U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on foreign published documents (“printed publications”), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

That the claimed plant was not publicly available in the United States more than one year prior to the date of domestic filing is noted but is not relevant to patentability, as there is no geographic component of enablement. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* 10 USPQ2d 1719, 1720 (Bd. Pat. App. & Inter. 1989), where a specification was found to be enabling even though the required biological material was not deposited, but was obtainable from specified locations in the ocean (specifically, only off the coast of Central and South America, as described in U.S. Patent 4,548,814, col. 1, lines 43-60).

Contrary to applicant's arguments, a printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301, f.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex Parte Thomson*, 24 USPQ-2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP 2121.03.

It has been determined, and explicitly conceded on the record by applicant, that the above referenced publicly available publication discloses the claimed plant variety and that said claimed variety was placed on public sale more than one year prior to the filing date of the subject application for United States Plant Patent.

As such, the published application, combined with the knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant. Information regarding the claimed variety, in the form of the publication noted above, was readily available to interested persons of ordinary skill in the art.

Contrary to applicant's continuing assertions, the facts in the instant case are not identical to those presented in *LeGrice*. The *LeGrice* decision states "The particular question of law to be here decided is presented on stipulated facts, which, insofar as they relate to the issue, are here quoted from the record..." 133 USPQ at 367. The list of facts that follows does not include the stipulation that the plants sought to be patented were on sale anywhere. Applicant *LeGrice* never stated that the claimed plants were on sale, nor did he provide copies of the catalogue publications (Brief, Appendix B, pages 10-11). It appears that the Board's conclusion that the plant was on sale and in public use in England had no basis in fact. Naturally, the applicant did not comment on this conclusion because the Board went on to state that it was irrelevant, i.e. not the basis for the rejection.

The *LeGrice* Court noted that "...only an 'enabling' publication is effective as a bar to a subsequent patent. We do not agree with the view expressed by the examiner that this necessarily requires that plant publications be 'totally ignored.'" 133 USPQ at 374. The *LeGrice* Court concluded, "The mere description of the plant is not necessarily an 'enabling' disclosure." 133 USPQ at 378. In the instant application, there is more than a "mere description" of the plant – there is also evidence of public availability of the same more than one year before the instant application was filed. The claimed plant is within the "knowledge of those skilled in the art" by virtue of its public availability. One skilled in the art would thus have known "how to make" the claimed plant upon reading the cited publications, by purchasing a clone of the plant and asexually propagating it by cuttings or any other known method in the art. Thus, the

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publications provide an enabling disclosure when combined with the knowledge of the skilled artisan.

Further as regards *LeGrice*, the issue of whether the plant stock had been in public use or sale over one year prior to filing was not before the Court. That the appearance of the 'Dusky Maiden' and the 'Charming Maid' rose varieties in catalogs and that they won certain awards indicates that the court must have recognized that they were in public use and that both roses were offered for sale at the time the catalogs were published is not factually substantiated. A "catalog" is not necessarily a listing for sale (in fact, the reference at issue did not appear to indicate how to place an order for the described roses). Also, it must again be emphasized that the rejection of record is not based upon "public use" of the referenced plant variety, but rather on its public availability.

The examiner again agrees that the publication "by itself" would not enable a person skilled in the art to reproduce the claimed plant. However, the availability of the plant whether through sale or other form of public availability would enable the disclosure of the printed publication.

The contention that foreign commercial availability or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States...". There is no geographic limitation of the bar under 35

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U.S.C. 102(b) to printed publications in this country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because as noted above, the current rejection under 35 U.S.C. 102(b) is based on a foreign published document ("printed publication"), as enabled by the admitted availability of the plants outside the United States more than one year prior to the date of domestic filing.

Therefore, a foreign disclosure describing the claimed subject matter, published over a year prior to the filing of the domestic application, is an enabling bar under 35 U.S.C. 102(b) where the plant stock necessary for the publication could have been obtained over a year prior to the domestic filing of an application.

The arguments that the *Thomson* decision is an "ill conceived notion action by the Patent Office administrative tribunal that is unsound from both technical and legal standpoints", that such is not in accordance to the law and is not applicable to the instant application as the *Thomson* application was drawn to a utility patent are noted but are not persuasive. *In re LeGrice*, 35 U.S.C. 161, and 36 CFR 1.161 clearly state that the same laws and rules relating to applications for utility patents also are applicable to plant patents except for the one exception set forth in 35 U.S.C. 162.

Public notice of a Plant Breeder's Right application informs the public of the existence of the plant. Notice and/or publication gives the name of the breeder/applicant, who can then be contacted to obtain the plant if it is on sale. Sale or other public use of said plant then puts it within the knowledge of one skilled in the art.

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If a printed publication, when taken in conjunction with the knowledge of those skilled in the art, provides an enabling disclosure, then the printed publication can be a statutory bar. The following is a passage from *LeGrice*, 133 USPQ at 379:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

The information in the relied-upon printed publication taken in conjunction with the knowledge of those skilled in the art (including the sale or public availability of the plant and methods of asexual propagation) would enable a person skilled in the art to reproduce the plant, thus the publication is a statutory bar under 35 U.S.C. 102(b).

The contention that asexually propagating the plant is not "making" the plant is not persuasive and is not supported by any legal authority. Asexual reproduction clearly makes what is claimed. Therefore, one of ordinary skill in the art can make and use (via asexual reproduction) the claimed invention without undue experimentation. There is no statutory requirement or case law specifying that for a prior art reference to be enabling, it must enable one skilled in the art to "make the plant of the invention from source material other than the plant itself."

Moreover, while asexual reproduction of a patented plant infringes a United States Plant Patent, independent creation of an identical plant, would not. See *Imazio Nursery Inc. v. Dania Greenhouses*, 26 USPQ2d 1673, wherein the conclusion of the CAFC was expressed as follows:

"In view of the statutory language, the legislative history, the case law, the views of the commentators, and a review of the relevant provisions of the PVPA, we

conclude that the scope of a plant patent is the asexual progeny of the patented plant variety. Variety as used in section 161 encompasses a single plant, the plant shown and described in the specification."

So, if this application were to mature into a patent, an identical plant produced by "independent creation" would not infringe the patent. In *Imazio Nursery Inc. v. Dania Greenhouses* (CA FC) 36 USPQ2d 1673, the court stated (page 1681):

The statute requires asexual reproduction of the patented plant for there to be infringement, it is necessarily a defense to plant patent infringement that the alleged infringing plant is not an asexual reproduction of the patented plant. Part of this proof could be, thus, that the defendant independently developed the allegedly infringing plant. However, the sine qua non is asexual reproduction. That is what the patentee must prove and what the defendant will seek to disprove.

Moreover, it is noted that the process of asexual reproduction and the plant so produced are the invention that is protected by a United States Plant Patent. As stated in 35 U.S.C. 163:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

Since the asexually reproduced plant is what is patented, the process for its production is, by definition, "making" the invention.

The above rejection and supporting rationale comports that offered by the examiner and with that which was affirmed by the Board of Patent Appeals and Interferences in the *Elsner* (Bd. Pat. Apps. & Interfs. Mar. 26, 2003) and *Zary* (Bd. Pat. Apps. & Interfs. Mar. 26, 2003) cases.

The CAFC, while agreeing with the basic rationale as had been presented by the examiner and BPAI, remanded the above cases purely for further development on the record with respect to the foreign sales of the subject plant; specifically as to whether the foreign sale was "*an obscure, solitary occurrence that would go unnoticed by those skilled in the art*", stating that the "*availability must have been known in the art, just as a printed publication must be publicly available*" with further elucidation being that such "*goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to*".

In the case of the instant cultivar, responsive to the requirement for information set forth on 5/26/05, applicant responded that "**The 'Meinusian' variety was identified in the Autumn-Winter 1996 catalog of Meilland Richardier that was made available to amateur rose growers solely in the country of France**" and "**plants of the 'Meinusian' variety were first made available to such amateur growers in the country of France during September, 1996**".

The above admission on the part of applicant does not constitute an obscure or single occurrence that would go unnoticed by those skilled in the art, even if one assumes, arguendo, that the referenced catalog was limited in distribution as alleged. However, the referenced catalog appears to be readily available on the internet by

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name and as such the allegation that its availability was limited to amateur rose growers in the country of France does not appear to be factually supported (rather it appears to be world-wide), absent evidence to the contrary for the time in question. Additionally, applicant's above referenced statement, even taken at face value, would not constitute an obscure occurrence given the number of rose growers and breeders in France. As such, "interested members of the relevant public could obtain the information if they wanted to."

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

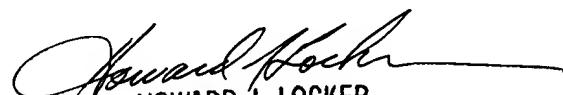
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax number for official correspondence is 571-273-8300.

Howard J. Locker/hjl
November 04, 2005


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661